

Appl. No. : 09/550,354
Filed : April 14, 2000

REMARKS

After entry of the foregoing amendment, claims 1-3, 5-19, 21-33 and 35-55 are pending in the application and are presented for reconsideration and further examination in view of the foregoing amendments and the following remarks. By the foregoing amendments, claims 1, 9, 11, 26, 32, 33 and 44 have been amended and claims 4, 20 and 34 have been cancelled without prejudice or disclaimer.

Rejections Under § 112

In the Office Action, claims 1-10, 12 and 22-32 were rejected under 35 U.S.C. § 112, ¶ 2, as being incomplete for omitting essential steps. Specifically, Claims 1, 12, 22 and 27 were rejected on the grounds that the claim "omits any limitation which would create or generate a set of individualized enhancements. This step is essential in order that the receiving step is realized." Applicant respectfully traverses this rejection.

Applicant respectfully submits that creating or generating a set of individualized enhancements is not essential and its absence from the claims does not amount to a gap between the steps. For example, with regard to claim 1, that claim is directed to a method for facilitating the creation of personalized products. The described method can be performed exclusively on the host merchant computer in one embodiment. The creation or generation of a set of individualized enhancements could involve steps or actions performed by a user. The steps or actions of the user are not being claimed. Rather, the claim is directed to the method which is performed by the host merchant computer. Applicant respectfully submits that they are not required to claim any additional steps. For example, if the method was directed to a system for measuring a signal, the Applicant would not be required to claim the generation of the signal. Therefore, Applicant respectfully requests the withdrawal of the rejections under § 112.

Claims 26, 32 and 44 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. Each of claims 26, 32 and 44 have been amended in view of the suggestions by the Examiner. Applicant submits that this rejection has been overcome by those amendments. Applicant further thanks the Examiner for suggesting proposed corrections to the claims and for examining the claims based on those assumed corrections.

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Rejections Under § 102

In the Office Action, claims 1-3, 5-6, 11-13, 16-17, 33 and 35-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Rosen (U.S. Patent No. 6,493,677). Independent claims 1 and 34 have each been amended to incorporate the limitations from a dependent claim which was rejected under § 103. Therefore, the patentability of each of the claims rejected under § 102 is addressed below in the section addressing the rejections under § 103.

Rejections Under § 103

In the Office Action, claims 4, 9, 15, 20, 22-24, 26-30, 32, 34, 37-41, 45-51 and 54-55 were all rejected under 35 U.S.C. § 103 as being unpatentable over Rosen (U.S. Patent No. 6,493,677) in view of Lahey (U.S. Patent No. 6,384,923). Applicant respectfully traverses this ground of rejection. Because independent claims 1, 11 and 33 have been amended to incorporate the limitations of dependent claims 4, 20 and 34, respectively, and because dependent claims 4, 20 and 34 were rejected under § 103, independent claims 1, 11 and 33 will be addressed in this section.

In general, all of the rejections of the independent claims are based on the combination of Rosen and Lahey. Applicant respectfully submits that Rosen and Lahey cannot properly be combined to support a rejection under §103. Rosen describes a method and apparatus for creating and ordering customized branded merchandise over a computer network. Specifically, Rosen describes a system and method that allows a customer to add a graphic image to a label on a bottle of soda. The system allows the customer to crop the graphic image or perform other types of image manipulations. *See*, Rosen, Title and Abstract. Lahey describes a method for the real-time customization of a dialog box for accessing a library within a network printing system. The customizable search dialog box is used to locate files in a network printing system when building print jobs. *See*, Lahey, Title and Abstract.

Rosen and Lahey are not in the same field of endeavor. The field of endeavor of Rosen is the customization of branded merchandise. The field of endeavor of Lahey is, generally, network printing systems and more specifically addresses the issue of building a print job with a customizable search dialog box. Please note that Lahey is classified in Class 358 (Facsimile and Static Presentation Processing), Subclass 1.13 (Emulation or Plural Modes). Rosen is classified in Class 705 (Data Processing: Financial, Business Practice, Management, a Course Cost/Price Determination), Subclass 27 (Presentation of Image or Description of Sales Item (e.g., electronic

catalog browsing)). M.P.E.P. 2141.01(a) states that the Patent Office classification of references is some evidence of “non-analogy” of art.

In addition, the Lahey reference does not address the same problems addressed by Applicant’s invention or addressed by Rosen. Rosen addresses the “need for a method and system for creating and ordering customized branded merchandise ~~which~~ allows the consumer to easily and conveniently purchase merchandise personalized to their own tastes.” Rosen, col. 1, ll. 49-53. On the other hand, Lahey is directed to network printing systems which include an assemblage of different printers, client computers, servers and other components connected over a network. Lahey asserts that in such systems a document may be comprised of multiple files with each one having one or more print attributes, that maintaining library storage of print files may be inadequate and that, therefore, there is a need for network printing systems that facilitate the printing of complex documents comprised of multiple files stored throughout a printing network. *See*, Lahey, col. 1, ln. 63 – col. 2, ln. 44. Therefore, Applicant respectfully submits that Lahey and Rosen are not analogous art, do not have structural or functional similarities, do not address the same or similar problems and therefore cannot properly be combined in a rejection under § 103.

In addition, even if portions of Lahey are improperly combined with Rosen, the claimed invention is not rendered obvious. Amended independent claims 1 and 33 have been amended to incorporate the limitations of dependent claims 4 and 34, respectively. Dependent claims 4 and 34 were rejected under § 103 in view of Rosen in combination with Lahey. It was admitted in the Office Action that Rosen does not teach that the design interface presents a default set of product configuration options and a default set of enhancements. Lahey was pointed to as providing that teaching. However, the portions of Lahey which were pointed to describe customizing a search dialog box. They further describe that that search dialog box can have default options. However, the search dialog box is used to search for job tickets and files in the InfoPrint Library 36. It does not present to a user a set of default product configuration options and a default set of enhancements. Rather, it presents default search options. Therefore, even if Lahey is combined with Rosen, it still does not teach or suggest the inventions of amended claims 1 and 33.

Amended claim 11 incorporates the limitations of dependent claim 20 which was rejected under § 103 in view of Rosen in combination with Lahey. Applicant respectfully submits that if

Rosen was to be combined with Lahey, the claimed invention is still not rendered obvious. In the Office Action, it is submitted that Rosen does not teach receiving a request to save the set of product configurations and the set of individualized enhancements and to store those in a location accessible to that user. The Office Action points to Lahey for meeting that limitation. However, the section of Lahey identified, again, deals with customized search dialog boxes. Those dialog boxes are used to locate files. Customizing the dialog box and saving those selected customizations is not the same and is not suggestive of saving product configurations and product enhancements.

Independent claims 22 and 27 were rejected over Rosen in combination with Lahey. It was admitted in the Office Action that Rosen fails to teach or suggest modifying a first set of design components and generating a second set of design components derived from the first set of design components. Lahey was pointed to for providing that teaching. However, again, the identified portion of Lahey deals with search dialog boxes 190, 202. Those dialog boxes are used to search the library. Certainly the dialog boxes themselves are not the same as a customized product.

Finally, independent claims 37 and 46 were also rejected over the combination of Rosen with Lahey. In the Office Action, it was admitted that Rosen fails to teach or suggest a design buffer in communication with the said design tools with the design buffer capable of containing product configuration options and individualized enhancements generated by the user. Lahey was pointed to for providing that teaching. Again, the portion of Lahey identified deals with the "set default" button which is used to customize search dialog boxes. Search dialog boxes and the customization of those boxes in no way corresponds to the customization of a product. Those dialog boxes are at no time produced or treated in any way like a product. Rather, they are used for the ease of locating files in a library.

In view of the foregoing, Applicant respectfully submits that each of the pending independent claims and the claims which depend therefrom are in condition for allowance. If the Examiner has any further questions regarding the foregoing, he is invited to contact the undersigned by telephone.

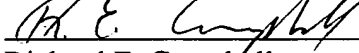
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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